

RESPONSE TO OFFICE ACTION

The Examining Attorney has refused registration of Applicant's mark SOLUTION in Class 28 for "archery equipment, namely, bows," asserting a likelihood of confusion with U.S. Registration No. 3,247,621 for SOLUTION in Class 28 for "sporting goods, namely, basketballs, backboards for basketball, basketball goal sets, basketball goals, and basketball nets." For the following reasons, Applicant respectfully requests reconsideration and withdrawal of the Section 2(d) refusal.

No likelihood of confusion exists between Applicant's applied-for mark and the registered mark. In In re E.I. duPont de Nemours & Co., 177 USPQ 563, 567 (CCPA 1973), the court outlined several factors to be considered in testing for likelihood of confusion under Section 2(d) of the Trademark Act. The Examining Attorney indicates that the duPont factors justifying a 2(d) likelihood of confusion rejection in this case are (i) the similarity of the marks, and (ii) the relatedness of the goods. Applicant submits that no likelihood of confusion exists between Applicant's mark and the cited mark due to (a) the dissimilarity of the goods, (b) the dissimilarity of the trade channels, and (c) the degree care taken by consumers of the goods of both marks.

I. Dissimilarity of the Goods

Applicant respectfully submits that the goods of the applied-for mark are sufficiently distinct from those of the registered mark for the reasons provided herein. Applicant's mark is for "archery equipment, namely, bows" in Class 28. The registered mark is registered in connection with "sporting goods, namely, basketballs, backboards for basketball, basketball goal sets, basketball goals, and basketball nets" in Class 28. In other words, the goods of Applicant's

applied-for mark and the goods of the registered mark are directed to two separate and distinct products: archery bows and basketball equipment.

The Examining Attorney relies on evidence from the websites of three large sports equipment retail companies to support the conclusion that the goods of Applicant's applied-for mark and the goods of the registered mark are "sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use." Further, the Examining Attorney relies on evidence of ten third-party registrations located on the USPTO's X-Search database to support the conclusion that the goods of Applicant's applied-for mark and the goods of the registered mark "are of a kind that may emanate from a single source under a single mark." Such limited evidence does not support the conclusion that the goods of Applicant's applied-for mark and the goods of the registered mark are related or complementary, and therefore, Applicant's applied-for mark does not create a likelihood of confusion with the registered mark.

First, a likelihood of confusion requires that the goods or services of two respective marks share more than a general relation or a connection to a general category. See Elec. Data Sys. Corp. v. EDSA Micro Corp., 23 USPQ2d 1460, 1463 (TTAB 1992) (holding that "the issue of whether or not two products are related does not revolve around the question of . . . whether both can be classified under the same general category"); see also In re Sears, Roebuck and Co., 2 USPQ2d 1312 (TTAB 1987). Further, just because goods are commonly sold within one store and "under the same roof" does not automatically mean that buyers are likely to be confused by similar marks on disparate goods as to source, connection, or sponsorship. Lever Bros. Co. v. Winzer Co. of Dallas, 140 USPQ 247 (CCPA 1964) (Applicant's VIE for dishwashing detergent was not likely to cause confusion with senior user's VIM for laundry detergent, even though they

were both sold in supermarkets.). Given the prevalence of “big box” stores in today’s marketing environment, such an argument is even less probative of likelihood of confusion now more than ever. Finally, the mere fact that two goods may be used together in the same setting or venue does not, in and of itself, demand a finding that confusion is likely. Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd., 73 USPQ2d 1350 (Fed. Cir. 2004) (“That two goods are used together, however, does not, in itself, justify a finding of relatedness.” No likelihood of confusion was found between RITZ for kitchen towels and aprons and RITZ for cooking classes.); In re Thor Tech, Inc., 113 USPQ2d 1546, 1551 (TTAB 2015) (finding use of identical marks for towable trailers and trucks not likely to cause confusion).

Second, third-party registrations that cover a number of different goods or services may have some probative value to the extent that they serve to suggest that goods or services are of a type that may emanate from a single source. However, the existence of any third-party registrations covering certain shared goods or services does not, in and of itself, support a conclusion that such goods or services are related. See In re Princeton Tectonics, Inc., 95 USPQ2d 1509, 1511 (TTAB 2010) (“While third-party registrations can play an important role in establishing that the types of goods at issue are related, examining attorneys must review the registrations carefully to ensure that each registration presented is probative and that the number of registrations is sufficient, along with other types of evidence, to establish that the types of goods at issue are related.”); TMEP § 1207.01(d)(iii).

Applicant respectfully submits that evidence provided by the Examining Attorney is insufficient to support a conclusion that the goods of the applied-for mark are related or complementary to the goods of the registered mark for the reasons provided herein.

Online evidence from large retail, “big box” stores does little to support the conclusion that contemporary consumers will consider certain goods to emanate from a single source under a single mark. Indeed, the online evidence relied upon by the Examining Attorney demonstrates several different marks used in connection with the specific subject goods on the websites. Additionally, the online evidence relied upon by the Examining Attorney further demonstrates that even the large retail, “big box” stores consider the goods of Applicant’s applied-for mark and the goods of the registered mark to relate to disparate categories of products—as evidenced by the stores’ respective online directories associated with the subject goods—which undermines any argument that the respective products share more than a general relation or a connection to a general category. Nonetheless, as explained above, just because goods are commonly sold within one store and “under the same roof” does not automatically mean that buyers are likely to be confused by similar marks on disparate goods as to source, connection, or sponsorship. Relatedly, the mere fact that two goods may be used together in the same setting or venue does not, in and of itself, demand a finding that confusion is likely—especially when the strongest argument is that the respective products merely relate to activities that could occur outdoors. Therefore, to the extent that the online evidence can establish that the goods of Applicant’s applied-for mark and the goods of the registered mark share even a general relation or connection to a general category, such evidence is insufficient to establish a likelihood of confusion.

Similarly, the Examining Attorney must ensure that any evidence of third-party registrations used to establish that certain goods are related is probative and that the number of provided third-party registrations is sufficient to support such a conclusion. Here, the evidence of third-party registrations presented by the Examining Attorney is not probative, and the third-

party registrations identified by the Examining Attorney are insufficient to conclude that the disparate goods of Applicant's applied-for mark and the goods of the registered mark are related. Therefore, such evidence is insufficient to support a conclusion that the compared marks create a likelihood of confusion.

II. Dissimilarity of Trade Channels

The goods of Applicant's applied-for mark and the goods of the registered mark are marketed to different classes of consumers in different marketing contexts and channels. Specifically, the "archery equipment, namely, bows" of Applicant's applied-for mark are to be marketed for shooting and hunting. Whereas, the "sporting goods" of the registered mark are specifically directed to "basketballs, backboards for basketball, basketball goal sets, basketball goals, and basketball nets." The market for archery-related shooting and hunting, generally, and bow-based shooting and hunting, specifically, are separate and distinct from the market for basketball-related recreation activities. Applicant respectfully submits that the goods of the applied-for mark are not confusingly similar to the goods of the registered mark for the reasons provided herein.

Even marks in complementary markets can cover goods that are distinctive enough that confusion would be unlikely where there are differences in the channels of trade. See In re Thor Tech, Inc., 113 USPQ2d at 1551 (finding use of identical marks for towable trailers and trucks not likely to cause confusion given the difference in the nature of the goods and their channels of trade and the high degree of consumer care likely to be exercised by the relevant consumers); TMEP § 1201.01(a)(i).

Here, the goods of Applicant's applied-for mark and the goods of the registered mark are directed to two separate and distinct markets: archery-related shooting and hunting and basketball-related recreation activities. Further, despite any argument regarding the potential complementary nature of the compared goods, no one seeking Applicant's goods, which are specialized for the intended purpose of archery-related shooting and hunting, will accidentally select the goods of the registered mark, which are expressly directed to "basketballs, backboards for basketball, basketball goal sets, basketball goals, and basketball nets," and vice versa. The dissimilarity of the markets and trade channels for the goods weighs against any likelihood of confusion.

III. Conditions Under Which Purchases are Made and Buyers to Whom Sales are Made

Applicant respectfully submits that the goods of the applied-for mark are not confusingly similar to the goods of the registered mark for the reasons provided herein.

The conditions under which consumers purchase goods and services, (i.e., whether purchasing decisions are made impulsively, whether the goods and services are expensive, or whether consumers are sophisticated) are also relevant in determining whether a likelihood of confusion exists. E.I. duPont, 177 USPQ at 567; McGregor-Dongles, Inc. v. Drizzle, Inc., 599 F.2d 1126, 1137–38, 202 USPQ 81, 92 (2d Cir. 1979), *superseded on other grounds by* Fed. R. Civ. P. 52(a).

In the present case, consumers will not be purchasing the goods of Applicant's applied-for mark on impulse. Nor are they purchasing the goods set forth in the registered mark on impulse. The goods of Applicant's applied-for mark are to be sold to sophisticated and discerning purchasers that exercise a heightened standard of care when considering Applicant's

goods. The goods of Applicant's applied-for mark are to be specialized for the intended purpose of archery-related shooting and hunting and, therefore, Applicant's customers are also likely to exercise a higher standard of care than other purchasers. Relatedly, the goods in the registered mark are offered to specific discerning purchasers as well, who are specifically seeking basketball-related equipment.

Taking all of these factors together, the level of consumer care and such conditions under which consumers purchase the goods of Applicant's applied-for mark prevent a likelihood of confusion.

IV. Conclusion

Due to the distinction between the goods, the differences in the channels of trade, and the differences in the purchasers to whom sales are made and the conditions under which sales are made, Applicant contends that there is no likelihood of confusion between its applied-for mark and the registered mark. Accordingly, Applicant respectfully submits that the application is now in condition for publication and courteously solicits the same.